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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,178	03/10/2004	Kiyoharu Nishiyama	250026US2 DIV	3502

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

HOYE, MICHAEL W

ART UNIT	PAPER NUMBER
2623	

NOTIFICATION DATE	DELIVERY MODE
06/29/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
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Office Action Summary

Application No. 10/796,178	Applicant(s) NISHIYAMA ET AL.
Examiner Michael W. Hoyer	Art Unit 2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 March 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 8-20 (based on a provisional rejection) is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
- Certified copies of the priority documents have been received.
 - Certified copies of the priority documents have been received in Application No. 09/238,639.
 - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/22/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Arguments***

1. Applicants' arguments, see Remarks/Arguments, filed on March 22, 2007, with respect to the rejection of claims 1 and 8-18 under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky et al (WO 94/03995) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration and in view of the new amendments to independent claims 1 and 13, a new ground(s) of rejection is made where claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,725,460, and claim 13 is rejected in a similar manner over claims 45-46 of the same patent. Although this pending application is a Divisional of application 09/238,639 USPN 6,725,460, the nonstatutory obviousness-type double patenting rejection is proper since no restriction was required by the Examiner during the prosecution of the parent application.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,725,460. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 and patented claims 1-2 are both directed to a delivery system for delivering contents... The claims differ in that claim 1 recites a remote monitoring unit configured to determine based on the received picture of the screen of said one of the terminal apparatuses whether any of the plurality of contents are displayed on the screen of said the one of the terminal apparatuses. The portion of the specification in USPN 6,725,460 that supports the recited remote monitoring unit that would anticipate claim 1 herein is found in col. 20, line 38 – col. 21, line 20 (also see col. 5, lines 39-50). Claim 1 cannot be considered patentably distinct over patented claims 1-2 when there is a specifically recited embodiment that would anticipate claim 1. Claim 1 cannot be considered patentably distinct over patented claims 1-2 when there is a specifically disclosed embodiment in USPN 6,725,460 that supports claims 1-2 and falls within the scope of claim 1 herein because it would have been obvious to one having ordinary skill in the art to modify the delivery system for delivering a plurality of contents of claims 1-2 by selecting a specifically disclosed embodiment that supports the claim. One of ordinary skill in the art would have been motivated to do this because that embodiment is disclosed as having further advantageous features within claims 1-2.

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4. Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 45 and 46 (or similarly claims 1 and 2) of U.S. Patent No. 6,725,460. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 and claims 45-46 of USPN 6,725,460 are both directed to a delivery method for delivering contents... The claims differ in that claim 13 recites determining based on the received picture of the screen of said terminal apparatus, whether any of the plurality of contents are displayed on the terminal apparatus. The portion of the specification in USPN 6,725,460 that supports the recited determining based on the received picture of the screen of said terminal apparatus, whether any of the plurality of contents are displayed on the terminal apparatus that would anticipate claim 13 herein is found in col. 20, line 38 – col. 21, line 20 (also see col. 5, lines 39-50). Claim 13 cannot be considered patentably distinct over patented claims 45-46 when there is a specifically recited embodiment that would anticipate claim 13. Claim 13 cannot be considered patentably distinct over patented claims 45-46 when there is a specifically disclosed embodiment in USPN 6,725,460 that supports claims 45-46 and falls within the scope of claim 13 herein because it would have been obvious to one having ordinary skill in the art to modify the delivery system for delivering a plurality of contents of claims 45-46 by selecting a specifically disclosed embodiment that supports the claim. One of ordinary skill in the art would have been motivated to do this because that embodiment is disclosed as having further advantageous features within claims 45-46.

Allowable Subject Matter

5. The following is a statement of reasons for the indication of allowable subject matter:

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As for independent claims 1 and 13 and dependent claims 8-12 and 14-20, the prior art, alone or in combination, does not explicitly recite a system and method wherein one of the terminal apparatuses sends the center system a picture of a screen of said one of the terminal apparatuses on which the contents received from the center system is displayed including all the limitations as explicitly recited in the claims.

Conclusion

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael W. Hoyer whose telephone number is **571-272-7346**. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at **571-272-7353**.

Any response to this action should be mailed to:

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Mail Stop _____
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

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Randolph Building
401 Dulany Street
Alexandria, VA 22314

Some correspondence may be submitted electronically. See the Office's Internet Web site <http://www.uspto.gov> for additional information.

Or faxed to: 571-273-8300

Hand-delivered responses should be brought to the Customer Service Window at the address listed above.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **571-272-2600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Michael W. Hoye
June 11, 2007


ANDREW Y. KOENIG
PRIMARY PATENT EXAMINER